

REMARKS

This paper responds to the Office Action mailed July 26, 2006. Claims 1-6 are pending in the application. Claims 1-6 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,839,877 to Iwata ("Iwata"). Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. JP11328181 to Matsumoto ("Matsumoto"), in view of Japanese Patent No. JP10222501 to Hayashi ("Hayashi"), in further view of U.S. Patent No. 5,675,817 to Moughanni et al. ("Moughanni"). The Information Disclosure Statement filed on April 2, 2004 has been placed in the application file but has not yet been considered as the Office Action alleges that the Information Disclosure Statement failed to comply with 37 C.F.R. § 1.98(a)(2). The Applicant respectfully traverses.

Information Disclosure Statement

The Office Action states that the Information Disclosure Statement filed on April 2, 2004 fails to comply with 37 C.F.R. § 1.98(a)(2), which requires, *inter alia*, a legible copy of each cited foreign patent document. The Applicant notes that the present application is a divisional of U.S. Patent Application No. 09/727,679, now U.S. Patent 6,839,877 to Iwata, the parent application. Of the references not considered by the Examiner, a number of these were made of record in the parent application, namely, reference BD, BE and BH (BF and BG, which have been considered by the Examiner, were also made of record in the parent application). When an application is a divisional application filed under 37 C.F.R. § 1.53(b), an Applicant need not resubmit copies of the documents made of record in the present application. See M.P.E.P. 609.02. Nonetheless, as a convenience to the Examiner, the Applicant has provided copies of all the documents the Examiner has not yet considered, including those that were made of

record in the parent application. As such, the Applicant strongly urges consideration of all the art submitted in the Information Disclosure Statement.

Double Patenting

The Office Action has rejected claims 1-6 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of Iwata. As pointed out above, the present application is a divisional of Iwata. Moreover, Iwata was subject to a requirement for restriction under 35 U.S.C. § 121, of which the present application is the divisional. Under 35 U.S.C. § 121, "a patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against the divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application." As the present application was filed as a result of the restriction requirement in Iwata, Iwata cannot be used as a ground for a rejection in the present case, including that of non-statutory obviousness-type double patenting. Accordingly, the Applicant urges reconsideration and withdrawal of the non-statutory obviousness-type double patenting rejection over Iwata.

Claim Rejections - 35 U.S.C. § 103

Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto in view of Hayashi and in further view of Moughanni et al. The Office Action rejects independent claim 1, the sole independent claim, over all three references in combination for the reasons given on pages 4-5. First, the references do not teach each and every limitation of the present invention. Obviousness can only be

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. For the reasons that follow, there is no motivation, teaching, or suggestion for combining Matsumoto with Hayashi and moreover, there is no motivation for combination either of these references with Moughanni such that it teaches each and every limitation of independent claim 1. Finally, Moughanni does not teach or suggest the recitation of an electronic mail.

Claim 1 recites "a method of displaying an electronic email comprising: receiving an electronic mail including a sentence as a conversation object sentence in a reception mode; automatically converts each of character string into a pictograph in said reception mode to produce a pictograph mixed sentence when said pictograph corresponding to said character string is defined . . .". At page 4, the Office Action admits that Matsumoto does not disclose that the mixed sentence is a pictograph mixed sentence and that the pictograph corresponding to said character string is defined. The Examiner then states that Hayashi "discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a conversation operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1)."

Hayashi does not teach a device that converts a character string into a pictograph in said reception mode, and hence cannot be combined with Matsumoto to render obvious a pictograph mixed sentence when said pictograph corresponding to said character string is defined. Hayashi does not teach or suggest a device that converts a character string into a pictograph, at best it shows single character

animation. Hayashi teaches *transliteration* software that is designed to assist a user in understanding kanji; it is learning software. The “various conversion functions” cited as motivation in the office action merely refers to the animation functions for the learning software. An exemplary animation image taught therein is an animation of making strokes for a Chinese character of a hieroglyphic character of kanji. The disclosure is wholly directed toward transliteration and not translation, and only single candidate alphabetic characters are changed to an image about the candidate alphabetic character (e.g., kanji) while performing a transliteration of the alphabetic character. In short, when a single alphabetic character is displayed, the single alphabetic character can be transliterated, and the single character can be changed into an image about the alphabetic character. In contrast, claim 1 recites that the present invention can automatically convert each of the character string into a pictograph in said reception mode to produce a pictograph mixed sentence. A device that carries out transliteration of candidate single alphabetic characters, and not translation, cannot be combined with a device that produces mixed sentences, much less a pictograph mixed sentence, since all that is taught or suggested is single character transliteration.

Turning next to Matsumoto, the primary reference, there is absolutely no express teaching or suggestion whatsoever in the entire reference that indicates that it should be combined with any device having pictographs or animation. Nor is there any implicit teaching or suggestion for the combination as the problem to be solved in Matsumoto is to provide a “natural translated sentence without feeling of incompatibility by displaying an unknown word at a prescribed position in the translating sentence translated into a second language by a translation means by display converted so as to be sounded by a conversion means.” In the Matsumoto disclosure, it teaches displaying “unknown words” as roman characters so that it can be phonetically sounded out instead of translated. Such a disclosure has nothing to do

with creating a pictograph mixed sentence – indeed it is more concerned with phonetic representation of unknown words rather than pictorial representations.

In short, there is absolutely no disclosure, teaching, or suggestion to combine the transliteration software of Hayashi with the translation device of Matsumoto such that it can produce the claimed invention.

Claim 1 also recites receiving an electric mail including a sentence as a conversation object sentence in a reception mode. The Office Action admits that Matsumoto and Hayashi do not explicitly disclose the electronic message as an electronic mail. According to the Office Action, Moughanni discloses “a user of a pager receiving an electronic message (electronic mail) in a language of their own and the message (mail) is translated to the default language of the user (abstract)”. As the Office Action acknowledges, Moughanni is directed toward a paging device and receiving pages. While the Office Action conclusorily equates pages with electronic mail, a page is not an electronic mail and a pager does not receive electronic mail unless it is specifically configured to do so as a separate function. Moughanni has no express or implicit teaching, disclosure, or suggestion that the device is anything other than a pager, and specifically limits all of its embodiments, claims and disclosure to a pager and paging input. Quite simply, Moughanni does not teach or suggest receiving electronic mail.

Moreover, while the Moughanni reference generally discloses receiving an electronic message in the language of choice of the user rather than the language of the sender, there is absolutely no teaching or suggestion for combining this device with any other machine translation device or character converter, much less one that displays pictographs mixed sentences. Indeed, it teaches away from such combinations in the background of the invention: “while translation devices do exist, such devices are often

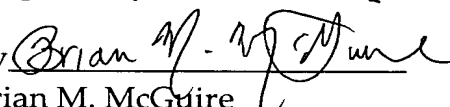
time consuming and detract from the convenience of a pager." Col. 1, line 37-39. Thus, there is no teaching, suggestion, or motivation for combining Moughanni with either Matsumoto or Hayashi. Similarly, the Matsumoto, Hayashi, and Moughanni, alone or taken together, do not teach each and every limitation of independent claim 1. Moreover, there is no teaching or suggestion for combining Matsumoto with Hayashi, and there is no teaching or suggestion for combining Moughanni with either Matsumoto or Hayashi much less the two taken together. Accordingly, the Applicant urges that claim 1 is allowable over the prior art of record. Because claims 2-6 ultimately depend from claim 1, and because neither Matsumoto nor Hayashi nor Moughanni make up for the deficiencies of these references as they are applied to independent claim 1, the Applicant urges that all the pending claims are in condition for allowance. The Applicant urges reconsideration and withdrawal of the rejections.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

No fee is believed to be due for this Amendment. Should any fees be required, please charge such fees to Deposit Account No. 50-2215.

Dated: October 26, 2006

Respectfully submitted,

By 
Brian M. McGuire

Registration No.: 55,445
DICKSTEIN SHAPIRO LLP
1177 Avenue of the Americas
41st Floor
New York, New York 10036-2714
(212) 277-6500
Attorney for Applicant

Attachments